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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,958	04/15/2004	Tamaki Kaneko	1461/72220	2278

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EXAMINER

NICHOLSON III, LESLIE AUGUST

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/826,958	Applicant(s) KANEKO, TAMAKI	
	Examiner Leslie A. Nicholson III	Art Unit 3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/15/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a first action on the merits of application 10/826958.

Election/Restrictions

2. Applicant's election with traverse of Species III in the reply filed on 10/11/2005 is acknowledged. The traversal is on the ground(s) that "each of the species is sufficiently related to be examined in one patent application". This is not found persuasive because the argument is not germane to species requirements. See MPEP 808.01.

The requirement is still deemed proper and is therefore made FINAL.

Specification

3. The disclosure is objected to because, as provided in 37 CFR 1.77(b), each of the section headings should appear in upper case, without underlining or bold type.

Appropriate correction is required:

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: at least A,B,C,D,E,En,F. There are several other instances of characters used, however not included in the drawings.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "En" has been used to designate at least a "pinion", a

Art Unit: 3651

"pulley", and a "rack". There are several other instances of characters used to reference different parts.

The specification should be carefully reviewed and corrected accordingly or corrected drawing sheets should be provided as outlined below.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
 - The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "the external apparatus" in line 2 of the claim.

There is insufficient antecedent basis for this limitation in the claim. Though "an

Art Unit: 3651

external apparatus" is recited in claim 1, it is the "first roller pair" that is being claimed.

See also ¶11.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-12 (see ¶11), as best understood by the examiner (see ¶6), are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada USP 5,762,328.

Regarding claims 1-11, Yamada discloses a similar sheet processing apparatus comprising:

- a first roller pair (upper roller pair 4) (fig.1)
- a second roller pair (lower roller pair 4) (fig.1)
- a jogging tray (21) (fig.1,2) (C3/L43-49)
- a binding device (11)
- a bulging device arranged at the conveying path (curve in conveying path after lower roller pair 4) (fig.1)
- a discharging device (10)

Regarding claim 12, Yamada discloses a similar sheet processing apparatus comprising:

Art Unit: 3651

- first means (upper roller pair 4) for conveying a sheet received from an external apparatus (C3/L19-22) (fig.1)
- second means (lower roller pair 4) for conveying the sheet from the first conveying means (fig.1)
- jogging means (9) for receiving the sheet conveyed from the second conveying means and jogging the received sheet (C3/L50-55) (fig.1,2)
- binding means (11) for binding a stack of sheets received and jogged by the jogging means (C3/L43-45) (fig.1)
- wherein the second conveying means can be driven to rotate such that the sheet received from the external apparatus and conveyed by the first conveying means one after another are pinched by the first conveying means one after another while being overlapped one upon another with leading edges thereof shifted stepwise one after another and are held by the second conveying means to be further conveyed to the jogging means (fig.1)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cook

USP 6,491,492 in view of Yamada USP 5,762,328.

Art Unit: 3651

Cook discloses a similar sheet processing method comprising:

- receiving a sheet conveyed from an external apparatus (12) at a speed (C2/L3-17) (fig.1)
- conveying the received sheet with a first roller pair (rollers associated with 40,42) at a circumferential speed corresponding to the speed (C2/L21-26)
- conveying the sheet conveyed from the first roller pair with a second roller pair (18) at the circumferential speed corresponding to the speed (C2/L35-38)
- receiving the sheet conveyed from the second roller pair and jogging the received sheet with a jogging tray (20) (C2/L66-67)
- wherein when the receiving and jogging step or the binding step is being performed, the second roller pair rotates at a decreased circumferential speed so that sheets received from the external apparatus and conveyed by the first roller pair one after another are pinched by the second roller pair one after another while being overlapped one upon another with leading edges thereof shifted stepwise one after another and are held by the second roller pair to be further conveyed to the jogging tray (C1/L29-53) (fig.1)

Cook does not expressly disclose the method step of binding a stack of sheet received and jogged by the jogging tray.

Yamada teaches the method step of binding a stack of sheets received and jogged by the jogging tray (C4/L54-64) for the purpose of properly aligning the stack of sheets.

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the method step of binding a stack of sheets received and jogged by the jogging tray, as taught by Yamada, in the method of Cook, for the purpose of properly aligning the stack of sheets.

Examiner's Note

11. The applicant has used means plus function in claims 1-11 and lines 10-16 of claim 12. Is 35 USC 112 6th paragraph being invoked? The examiner will interpret these claims to not invoking 35 USC 112 6th paragraph. See MPEP 2114 and 2181.

Claim 12 appears to be invoking 35 USC 112 6th paragraph and will be examined accordingly.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3651

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

L.N.
11/16/2005



GENE O. CRAWFORD
SUPERVISORY PATENT EXAMINER